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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,957	01/11/2001	Robert N. Hanson	ZAA-011.01	9648

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FOLEY HOAG, LLP
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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 07/18/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.
09/758,957

Applicant(s)
Hanson et al

Examiner
Maurie G. Baker, Ph.D.

Art Unit
1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun 24, 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: Please see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 15, 17-20, 22, 24-27, and 43

Claim(s) withdrawn from consideration: 29, 31-34, 36, and 38-41

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

10. ☐ Other: _____

MAURIE G. BAKER, PH.D.
PRIMARY EXAMINER
ART UNIT 1639


ADVISORY ACTION

Attachment

1. Applicant's After Final amendment filed June 24, 2003 raises new issues which would require further search and/or consideration and does not place the case in better form for appeal or in condition for allowance. Moreover, the proposed amendment contains new matter. Thus the amendment will not be entered.
2. The proposed claims would require, at the least, new rejections under 35 U.S.C. 112, first paragraph. Specifically, the proposed claims are *new matter*. The specification as originally filed does not provide support for the proposed claims. Applicant's amendment asserts that "the specification gives ample support for the claimed compounds" (After Final, page 5); however, the Response does not point to any specific support for the newly proposed generic structures (i.e. formula (II)) and the generic structure does not appear anywhere in the instant specification. The specification as originally filed includes only two specific structures that would read on the presently claimed generic (i.e. Figure 9). This is deemed to be insufficient support for the newly recited generic which encompasses a wide variety of compounds outside of those presented in Figure 9. For example, consider just the members of the proposed Markush group for R₁. The two compounds of Figure 9 contain a COOH group at this position only. So, there is only support for the proposed R₁ = -CO₂R₄ where R₄ = H. However, R₄ also recites alkyl, aryl, alkenyl, alkynyl, heteroalkyl or heteroaryl. H is not sufficient support for alkyl, aryl, alkenyl, alkynyl, heteroalkyl or heteroaryl. Moreover, the proposed Markush group for R₁ goes on to recite -CO₂N(R₄)₂, aryl, alkyl, aralkyl or aralkenyl. COOH is not sufficient support for -CO₂N(R₄)₂, aryl, alkyl, aralkyl or aralkenyl. The same is true for the rest of the R groups in the proposed generic structure.
3. Applicant's arguments are moot in view of the non-entry of the amendment. Due to the non-entry of the amendment, all previous rejections are maintained for reasons of record. However, in the interest of compact prosecution, the following is noted.

4. A claim limited **ONLY** to the two species referred to above from Figure 9 (i.e. those specific compounds recited in proposed claim 59) would be allowable if written in independent form and submitted in a separate, timely filed amendment.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
July 17, 2003



MAURIE GARCIA BAKER PH.D.
PRIMARY EXAMINER